

Remarks/Arguments:

Claims 1-22 were originally pending in this application. In response to the Restriction Requirement dated June 30, 2004, Applicants elected to prosecute claims 1-16. Claims 17-22 are therefore cancelled without prejudice.

Claims 1, 3-7, 11, and 14-15 stand rejected under 35 U.S.C. § 102(b) as anticipated by Burton et al (U.S. Patent No. 5,078,720)("Burton"). Claims 2, 8-10, 12-13, and 16 stand rejected under 35 U.S.C. 103(a) as unpatentable over Burton. Applicants respectfully traverse these rejections, but respectfully submit that the currently pending claims, as amended, are patentable over the art of record for at least the reasons set forth below.

Features of Amended Claims 1 and 16

Applicants' invention, as recited by amended claims 1 and 16, includes limitations that are neither disclosed nor suggested by the art of record (emphasized by underlining in the excerpts from claims 1 and 16 below), namely:

1. ...an inflatable balloon mounted radially outside the retrograde portion, **the balloon positioned to anchor a proximal portion of the endoluminal device against the body lumen during deployment of the device.** (emphasis added)
16. ...a balloon located radially outward of the external wall at or near the retrograde portion distal end **for anchoring the endoluminal device against the body lumen during deployment of the device from the device proximal end to the device distal end**.... (emphasis added).

Rejections under 35 U.S.C. § 102 and § 103 based on Burton

The Office Action rejects claim 1 under § 102(b) and claim 16 under § 103(a) based upon Burton. Burton, however, only shows an inflatable balloon that operates as a radially expandable stop means that is "adapted, when inflated, to be positioned adjacent the external sphincter." Thus, the balloon, as illustrated and described, is positioned to be expanded outside the external sphincter (and outside the body) to fix the instrument at the desired location.

In contrast to the device disclosed by Burton, Applicants' claimed invention is a device comprising an inflatable balloon *positioned to exert radial force* that presses the proximal portion of the endoluminal device *against the body lumen wall* during deployment of the device. Burton does not teach or suggest this limitation, nor can the device disclosed by Burton be modified to include this limitation without defeating the purpose of the balloon provided by Burton. Accordingly, Burton neither anticipates nor renders obvious the claimed invention, and

the rejections of claims 1 and 16 should be withdrawn. Dependent claims 2-15 should be allowed, at least as being dependent upon an allowable base claim.

Furthermore, the Office Action concedes that Burton fails to disclose (1) the annular lumen in the retrograde portion for fluid communication to the balloon, as recited in claims 2 and 16; (2) the radiopaque markers of as recited in claims 8-10; and (3) use of the device with an endoprosthesis as a stent or a stent-graft or a filter, as recited in claims 12-14. The Office Action contends that all of these limitations would be obvious design choices. Applicants respectfully disagree. The Office Action fails to show any suggestion or motivation as to how or why one skilled in the art at the time the invention was made would practice Burton with these limitations. In the absence of such suggestion or motivation, the only disclosure of these features is in Applicants' specification, and the rejections are therefore based upon impermissible hindsight and should be withdrawn.

In view of the amendments and arguments set forth above, applicants submit that the above-identified application is in condition for allowance.

Respectfully submitted,



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